

Practitioner's Docket No. MPI98-075CP1M**REMARKS**

The rejections under 35 USC § 101 and 35 USC §112, first paragraph were vacated by the Board after appeal. The Board issued a new ground of rejection under 37 CFR §1.196(b).

Claims 32-59 were under appeal. In response to the Decision on Appeal, Applicants have amended claims 32, 37, 42, 47, 52, 54, 56, and 58. Claims 33, 38, 43, and 48 have been cancelled.

Claims 32-59 were rejected by the Board under 35 USC 102(e) as anticipated by Elshourbagy (U.S. Patent 6,071,722). Applicants respectfully traverse the rejection. As the Examiner indicated in the office action dated 07/03/01 when Elshourbagy was cited, the reference is not considered pertinent to Applicant's disclosure.

Applicants respectfully point out the Elshourbagy reference does not teach each and every aspect of the presently claimed methods. In the Board's rejection, they noted "it is well settled that an anticipatory reference need only teach how to make the claimed invention under review..." (See Decision on Appeal, at page 5, lines 2-3). Applicants submit that with regard to the recited method claims, Elshourbagy contains no teaching whatsoever as to the types of cells which naturally express the 14296 receptor polypeptide defined in SEQ ID NO:1 apart from use of a testis cDNA library for identification of the sequence of using an EST nucleotide sequence. See, e.g., at column 5, lines 9-10. While Elshourbagy teaches the sequence of the polypeptide defined in SEQ ID NO:1, this alone is not sufficient teaching as to how to carry out the claimed invention under review.

Applicants further submit Elshourbagy has not taught modulation of activity in any cells which naturally express the polypeptide comprising the amino acid sequence shown in SEQ ID NO:1. The Board asserts Example 1 provides such a teaching, however, Example 1 merely describes use of a common cell line HEK293, for use in transfection experiments for recombinant expression of the polypeptide. Applicants submit the claimed methods are distinct in that a specific direction is provided to assess those cells which naturally express the polypeptide and thus would be more useful for assessment of modulators of natural activity of the polypeptide. Applicants submit the cell types which naturally express the polypeptide were intended and would be well understood to those of skill in the art in the context of the claimed methods, as well as Applicants disclosure in the specification. However, in an effort to further prosecution, Applicants have amended claims 32, 37, 42, 47, 52, 54, 56, and 58 to remove reference to kidney cells, as well as for clarification of the types of cells used in the presently claimed methods. Reconsideration and withdrawal of the rejection under 35 USC §102 is respectfully requested.

It is believed the present claims are free of the art and in condition for allowance. Early notice to this effect is solicited.

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This paper is being filed timely and it is believed no extensions of time are required. In the event any fees or extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

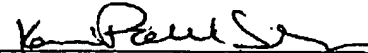
Entry of the remarks made herein is respectfully requested.

28 September 2004

Respectfully submitted,

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